UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,396	07/03/2001	Jean L. Spencer	29499/PM265A	7459

4743 7590 03/28/2002

MARSHALL, GERSTEIN & BORUN
6300 SEARS TOWER
233 SOUTH WACKER
CHICAGO, IL 60606-6357

EXAMINER
FAISON, VERONICA F

ART UNIT	PAPER NUMBER
1755	5

DATE MAILED: 03/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

MFS

Office Action Summary	Application No.	Applicant(s)	
	09/898,396	SPENCER ET AL.	
	Examiner	Art Unit	
	Veronica F. Faison	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-26 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-26 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefore ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-3, 5-7, 21 and 24 provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 2, 4-7, 21 and 24 of copending Application No. 09/608,925. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10, 15-22 and

26-29 of copending Application No. 09/609,811. Although the conflicting claims are not identical, they are not patentably distinct from each other because both teach erasable ink comprising a pigment have a "flake-like" morphology wherein the pigment is selected from pearlescent pigments.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 4, 8-20, 22, 23, 25 and 26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3, 8-20, 22, 23, 25 and 26 of copending Application No. 09/608,925. Although the conflicting claims are not identical, they are not patentably distinct from each other because both teach erasable ink comprising a pigment have a "flake-like" morphology wherein the pigment is selected from mica flakes, graphites, pearlescent, and metal flakes.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1, 2, 4-9, 11-15, 17-22 and 24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 5, 7-9, 20-25, 33, 34, 36, 38 and 40 of copending Application No. 09/898,942. Although the conflicting claims are not identical, they are not patentably distinct from each other because both teach an erasable ink comprising a pearlescent pigment.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim1, 3, 5-7, 21 and 24 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 5, 26-28, 32, 33, 35, 38-40, 61 and 62 of copending Application No. 09/553,119. Although the conflicting claims are not identical, they are not patentably distinct from each other because both teach an erasable ink comprising a graphite pigment.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 8, 14, and 21-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 8,14, and 21-26 are considered vague and indefinite since the term "like" is appended to an otherwise definite phrase (i.e. flake-like). See Ex parte Copenhaver, 109 USPQ 118. The examiner suggests the deletion of the term "like".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

> the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsujio (US Patent No. 6,306,930 B1).

Tsujio teaches an aqueous ink composition which is an erasable composition. The reference further teaches that the colorant present may be selected from an inorganic pigment such as graphite. The colorant may have a shape, which may be flaky (col. 2 lines 59-60) and are present in the amount from about 1 to 40 percent by weight (col. 2 lines 64-67). The reference remains silent as to what the shear-thinning index is, however the ink taught by the reference would obviously have the same shear-thinning index, because they use the same components comprised in the ink composition. The ink composition may contain from about 60 to 95 percent by weight of water. The viscosity of the ink composition may be about 100 to 10,000 mPa•s (col. 5 lines 8-24). The reference remains silent to the percentage of erasability of the ink composition, however the ink as taught reads on applicant's claimed invention having the same components therefore it would obviously have the same erasability that applicant has claimed. The reference further teaches that the ink composition may be used in all sorts of writing tools which includes ball-point pens, wherein the ball-point pen has an ink container tube or pipe (i.e. reservoir) containing the erasable ink composition (col. 5 lines 37-49).

Tsujio is described above but fails to specifically exemplify the use of a pigment having a flake morphology as claimed by applicant. Therefore, it would have been obvious to one of ordinary skill in the art to use the pigment having a flake morphology

as claimed by applicant as Tsujio also discloses the use of these pigments but shows no example incorporating them.

When general conditions are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by changing the size, shape, proportion of shape, degree and sequence of added ingredients through routine experimentation. (In re Rose, 105 USPQ 137; In re Aller 220F, 2d 454, 105 USPQ 233,235 (CCPA 1955); In re Dailey et al., 149 USPQ 47; In re Reese, 129 USPQ 402; In re Gibson, 45 USPQ 230).

Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyajima et al (US Patent 4,687,791).

Miyajima et al teach an erasable ballpoint pen comprising a rubber component, a volatile solvent, a pigment and a non-volatile solvent, which additionally comprises finely divided powders of an inorganic compound (col. 1 lines 62-66). The pigments include inorganic pigments such as graphite wherein the particle size is not more than 5 microns and in the amount of 12 to 35 percent by weight (col. 3 line 61-col. 4 line 1). The reference remains silent as to what the shear-thinning index is, however the ink taught by the reference would obviously have the same shear-thinning index, because they use the same components comprised in the ink composition.

Miyajima et al is described above but fails to specifically exemplify the use of a pigment having a flake morphology as claimed by applicant. Therefore, it would have been obvious to one of ordinary skill in the art to use the pigment having a flake

morphology as claimed by applicant as Miyajima et al also discloses the use of these pigments but shows no example incorporating them.

When general conditions are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by changing the size, shape, proportion of shape, degree and sequence of added ingredients through routine experimentation. (In re Rose, 105 USPQ 137; In re Aller 220F, 2d 454, 105 USPQ 233,235 (CCPA 1955); In re Dailey et al., 149 USPQ 47; In re Reese, 129 USPQ 402; In re Gibson, 45 USPQ 230).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Veronica F. Faison whose telephone number is 703-305-3918. The examiner can normally be reached on Monday-Thursday and alternate Fridays 8 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on 703-308-3823. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Veronica Faison
March 21, 2002

HELENE KLEMANSKI
PRIMARY EXAMINER
GROUP 1100